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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,928	06/13/2006	Denis Sergeevich Milov	42P22624	9221

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP  
1279 OAKMEAD PARKWAY  
SUNNYVALE, CA 94085-4040

EXAMINER
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CHANG, JON CARLTON

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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10/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,928	<b>Applicant(s)</b> MILOV, DENIS SERGEEVICH	
	<b>Examiner</b> JON CHANG	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/13/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/11/06, 11/17/06</u> .                                       | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 1-8 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. The Federal Circuit<sup>1</sup>, relying upon Supreme Court precedent<sup>2</sup>, has indicated that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at 590”). While the instant claims recite a series of steps or acts to be performed, the claims neither transforms an article nor are positively tied to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be “tied” to another statutory category, the structure

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<sup>1</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

<sup>2</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly. Consider claim 1.

The claim is not tied to a particular machine because the structure of another statutory category is not positively recited in a step significant to the basic inventive concept, and the steps of the claim could reasonably be construed as being performed manually.

The claim also does not satisfy either of the two aspects of the transformation test:

1) It does not transform a particular article to a different state or thing; no physical transformation is claimed.

2) It does not satisfactorily transform data because:

a) the data (i.e., the image) is not required to represent a real world/physical object;

b) there is no external, non-data representation of the physical object represented by the modified data.

The dependent claims do not add anything which would cause the claims to become statutory. In order to obviate this rejection, the Examiner suggests either one of the following options:

1) include language in the claim which requires meaningful and significant steps (such as the various determining steps and the calculating step) be performed by a particular machine (i.e., not a generic “machine” or “device”); or,

2) require that the data represent a real world/physical object, and include an additional step which requires depiction of a non-data representation (this could be a visual depiction) of the resulting data

4. It is noted that option 2) above may not be supported by the original disclosure since the intent is not to represent real world or physical objects. Nevertheless, any language added to the claims must find support in the original disclosure, in order to avoid a rejection under 35 U.S.C. 112, 1st paragraph (new matter).

5. Claims 9-16 are drawn to a "machine accessible medium". The claims do not define a "computer-readable medium" or "computer-readable memory" and are thus non-statutory for that reason. (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV. See also MPEP 2106). It is noted that merely reciting functional descriptive material as residing on a "tangible" or other medium is not sufficient. If the scope of the claimed medium covers media other than "computer readable" media (e.g., "a tangible media", a "machine-readable media", "computer usable media", etc.), the claim remains non-statutory. The full scope of the claimed media (regardless of what words applicant chooses) should not fall outside that of a computer readable medium.

6. Claims 17-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 17 defines a system. However, the body of the claim lacks definite structure indicative of a physical apparatus. The language in the preamble, "for automatically controlling execution of an application program having a graphical user interface" is considered a field-of-use or intended-use limitation and does not cause the claim to fall into one of the statutory categories of invention. Furthermore, the specification indicates that the invention may be embodied as pure software (page 18, line 32). Therefore, the claim as a whole appears to be nothing more than a system of software elements, and software *per se* does not fall within a statutory category. Computer programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

***Subject Matter Not Found in the Prior Art***

7. The subject matter of claims 1, 9 and 17 was not found in the prior art. Allowability is not indicated in view of the rejection under 35 U.S.C. 101.

***Citation of Pertinent Prior Art***

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication 20060005132 to Herdeg, III, teaches a framework for recording and replicating GUI activity.

U.S. Patent Application Publication 20050278728 to Klementiev discloses techniques and tools for recording input from user actions in a user interface and replicating the actions.

U.S. Patent 5,748,499 to Trueblood teaches a method and apparatus for recording and playing back computer graphics data

U.S. Patent 6,865,302 to Chang discloses a content-based image retrieval system which utilizes a triangle to capture spatial relationships between major pixel sets in an image.

U.S. Patent 6,542,638 to Campbell discloses a method for matching spatial patterns which matches triangles.

U.S. Patent 6,445,390 to Aftosmis et al. discloses triangle geometry processing for surface modeling and Cartesian grid generation which utilizes triangle filtering.

"How to Test Graphical User Interfaces" by Daboczi et al. teaches a tester that simulates a user and is used to test GUI's in the MATLAB environment.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JON CHANG whose telephone number is (571)272-7417. The examiner can normally be reached on M-F 8:00 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571)272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jon Chang  
Primary Examiner  
Art Unit 2624

/Jon Chang /  
Primary Examiner, Art Unit 2624